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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/769,363 | 01/26/2001 | Yoshihiro Ishida | 35.G2725 | 4785 |
| 5514 | 7590 | 11/02/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | PHAM, THIERRY L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/769,363 | ISHIDA ET AL. | |
| | Examiner | Art Unit | |
| | Thierry L. Pham | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on RCE filed on 8/4/05.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-23 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 8/4/05.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 8/4/05.
- IDS filed on 8/4/05 has been considered and entered by the examiner.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection of newly found prior art reference.

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

Medium as cited in claim 1 is directed to a non-statutory subject matter, for example, medium can be interpreted as a “paper media” containing printed computer program instructions. The examiner recommends the applicants to replace “medium” with “computer readable medium” so it compliances with 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5621810), and in view of Ogaki et al (US 6643028).

Regarding claim 1, Suzuki discloses an image processing apparatus (copy machine, fig. 2) comprising:

- image-data input means (image scanner 201, fig. 2, col. 4, lines 1-20) for inputting image data;
- specific-image determination means (prohibition pattern detection means, fig. 36, col. 2, lines 1-50 and col. 4, lines 36-64) for determining whether the image data inputted by said image-data input means represents a specific image having predetermined characteristics (i.e. digital watermark, figs. 14-15).

However, Suzuki does not expressly disclose (1) re-input determination means for determining whether to output a signal urging re-input of the image data input by said image-data input means; and (2) signal output means for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means, in accordance with a difficulty of determining whether the image data represents a specific image.

Ogaki, in the same field of endeavor for image processing apparatus, discloses (1) re-input determination means (re-reading if first reading is the image is lightly read and/or difficult to read, col. 1, lines 25-40 and col. 2, lines 1-10) for determining whether to output a signal urging re-input of the image data input by said image-data input means; and (2) signal output means (outputting a signal for urging re-input of the original to be re-scan and/or re-read, fig. 6, col. 2, lines 1-10 and col. 8, lines 10-28) for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify image processing apparatus of Suzuki to include a re-input means for re-input original image to read again because of difficulty of reading the first scan as per teachings of Ogaki (*manually rescanning of previous scanned originals due to positional error such as that the original is placed upside down, placement angle greater than zero, density is too light/dark, and etc which makes the scanned image difficult to read is well known and widely used in the art*) because of a following reason: (1) to accurately prevent forgery of security marks/originals (Suzuki, col. 2, lines 20-32); (2) to read a document including originals of plural pages and confirm whether the image which the user can utilize without any problem by use of the client PC is read or not on the spot in order to obtain high quality images (col. 7, lines 13-20 of Ogaki); (3) unnecessary prints can be prevented from being output and only the reread images which the user wants to check can be efficiently confirmed (col. 10, lines 52-62 of Ogaki).

Therefore, it would have been obvious to combine Suzuki with Ogaki to obtain the invention as specified in claim 1.

Regarding claim 2, Suzuki further discloses an image processing apparatus according to claim 1, wherein said specific-image determination means determines whether the image data obtained from said image-data input means represents a copy-prohibition image (i.e. money, fig. 14a).

Regarding claim 3, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether re-input of image data is to be urged, by determining difficulty (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) in determination whether the image data represents the specific image.

Regarding claim 4, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means determines whether re-input of image data is to be urged by determining difficulty (pattern matching determination means by determining

position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) in determination whether the image data represents a copy-prohibition image.

Regarding claim 5, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means comprises difficulty calculation means (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) for calculating difficulty in determination whether the image data represents the specific image, and difficulty determination means for determining whether the determination of said specific-image determination means is difficult based on the difficulty calculated by said difficulty calculation means.

Regarding claim 6, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means comprises difficulty calculation means for calculating difficulty in determination whether the image data represents a copy-prohibition image, and difficulty determination means (col. 2, lines 1-50 and cols. 9-10) for determining whether the determination whether the image data represents a copy-prohibition image is difficult, based on the difficulty calculated by said difficulty calculation means.

Regarding claim 7, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether the re-input is to be urged, from data based on a position of an original (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) in an image represented by the input image data.

Regarding claim 8, Suzuki further discloses an image processing apparatus according to claim 5, wherein said difficulty calculation means calculates the difficulty in the determination of the specific image, from data based on a position (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination by said specific-image determination means is difficult, by comparing data of the difficulty calculated by said difficulty

calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 9, Suzuki further discloses an image processing apparatus according to claim 6, wherein said difficulty calculation means calculates the difficulty in the determination of a copy-prohibition image, from data based on a position (position calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination of a copy-prohibition image is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 10, Suzuki an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is an angle (angle calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of the original with respect to a scanning direction (fig. 1) of the image represented by the input image data.

Regarding claim 11, Suzuki further discloses an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is a deviation (i.e. angular and positional difference, cols. 8-10) of the original from a predetermined position with respect to a scanning direction of the image represented by the input image data.

Regarding claims 12-22: Claims 12-22 are the method claims corresponding to the apparatus claims 1-11. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-11 above.

Claim 23 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers

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have some type of computer readable memory medium (RAM, fig. 4) for storing computer programs; therefore, claim 23 would be rejected using the same rationale as in claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 5719968 to Hashimoto, discloses a method for scanning originals and automatically adjusting the originals without having to re-scan and/or re-input the originals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER